

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to claim 4 because it is dependent upon a canceled claim. In response, claim 4 has been amended to depend from claim 1. Accordingly, it is respectfully requested that the objection to claim 4 be withdrawn.

In the Official Action, the Examiner maintains similar rejections from the previous Final Official Action. Specifically, the Examiner rejects claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,575,757 to Kennedy et al., (hereinafter "Kennedy"). The Examiner further rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Kennedy in view of Japanese Patent No. 11-216102 to Yamaguchi (hereinafter "Yamaguchi "). Lastly, the Examiner rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Kennedy.

In response, claim 1 has been amended to clarify its distinguishing features. Specifically, claim 1 has been amended to recite:

an elastic member interposed between the front end of the cylindrical hollow member for holding the imaging device and an inner side of a front end of the case for hermetically storing the optical elements and the camera assembly such that the cylindrical hollow member is constrained to only move in one optical-axis direction.

The elastic member (e.g., the compression coil spring 227) makes it possible to minimize the backlash of the cylindrical hollow member that holds the imaging device. Such an advantage has heretofore been unrecognized in the art, including by Kennedy and Yamaguchi. The present amendment to claim 1 is fully supported in the original disclosure. Therefore, no new matter has been entered into the disclosure by way of the present

amendment to claim 1. Neither Kennedy nor Yamaguchi disclose or suggest such an elastic member configuration.

With regard to the rejections of claim 1 under 35 U.S.C. § 102(b), an imaging unit for an endoscope having the features discussed above and as recited in amended independent claim 1 is nowhere disclosed in Kennedy. Since it has been decided that “anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,”¹ independent claim 1, as amended, is not anticipated by Kennedy. Accordingly, independent claim 1 patentably distinguishes over Kennedy and is allowable. Consequently, the Examiner is respectfully requested to withdraw the rejection of claim 1 under 35 U.S.C. § 102(b).

With regard to the rejections of claims 2 and 4, under 35 U.S.C. § 103(a), since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 2 and 4 are at least allowable therewith because they depend from an allowable base claim.

In other words, Independent claim 1, as amended, is not rendered obvious by the cited references because neither the Kennedy patent nor the Yamaguchi patent, whether taken alone or in combination, teach or suggest an endoscope having the features discussed above. Accordingly, claim 1, as amended, patentably distinguishes over the prior art and is allowable. Claims 2 and 4, being dependent upon claim 1, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 2 and 4 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli", written over the printed name.

Thomas Spinelli
Registration No.: 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
TS:cm